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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/350,983

Applicant(s)

PORAT ET AL.

Examiner

JAGDISH N PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 July 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-82, 101-112 is/are rejected.
- 7) ☒ Claim(s) 83-100 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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#### DETAILED ACTION

#### *Specification*

1. The disclosure is objected to because of the following informalities: Detailed description does not describe Figures 31-60. These figures should be described to show their pertinence to the invention recited in the detailed description.

Appropriate correction is required.

#### *Claim Objections*

1. Claims 2-6, 34-36 and 83-100 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 2 recites steps, which do not further limit parent claim. As an example, inputting, finding and communicating steps have no relationship to any of the limitations of claim 1. This deficiency also applies to dependent claims 3-6.

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Claims 83-100 recite steps, which do not further limit parent claim. As an example, limitations "selling information about the auction" (claims 83-94) and "selling information about the buyer" (claims 95-100) do not limit parent claim 1 any further because the aforementioned limitations of dependent claims 83-100 are unrelated invention recited in claim 1. As recited in the preamble of claim 1, the invention pertains to "facilitating auction between a prospective buyer and a plurality of sellers". In contrast, claims 83-100 pertain to selling information about the auction or the buyer.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 34-36 and 38-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 34-36 recite the limitation "searching for a database for offers.." in line 2 of claim 34. There is

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insufficient antecedent basis for this limitation in the claim. Claim 34 or parent claim 1 must recite a limitation to store the offers into the database.

5. Claim 38 recites the limitation "information about the buyer" in line 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 38 depends on claim 1 which only provides for "a buyer's request". However, there is no recitation of "information about the buyer" which is distinct from the information about the buyer's request.

Claims 39-46 depend on claim 38 therefore inherit same weakness as parent claim 38.

Claims 52-56 and 71-75 recite limitation "communicating of seller offers and rating information" in lines 1 and 2 (example Claims 52, 71). There is insufficient antecedent basis for this limitation in the claims. Parent claim 1, only recites "communicating information regarding at least some of the seller offers".

Claims 52, 54, 71 and 73: recite that the seller offers and rating information takes place before (claim 52) or after (claim) the auction period. However, this limitations contradict with the definition of the term "auction period" itself which

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that time duration in which the auction is open for receiving bids. This has been further confirmed by step f) of claim 1, which recites "receiving an adjusted offer .. during a specified auction period". Recitation of auction process in different time frames as in claims 52 and 54 renders claims indefinite and unclear.

This analysis also applies to claims 71 and 73 respectively.

Claims 102-105 recite limitation "the electronic transaction at an electronic site .." in claims 102 and 105, as an example. There is insufficient antecedent basis for this limitation in the claim.

Dependent claims 103-104 depend on claim 102 and inherit same deficiency.

Claim 109-111: as an example claim 109 recites limitation "the step of communicating information about regarding at least some of the seller offers and at least part of the rating information..". There is insufficient antecedent basis for this limitation in the claim.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 7-15, 18-29, 30-33, 37-39, 47-51, 53, 62-70, 74, 76-82, 101 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alaia et al. US 6,408,283) (Alaia) and further in view of Gindlesperger (US Pat. 6,397,197) hereafter, referred to as Gindlesperger.

Claim 1: Alaia discloses a fully automated method of facilitating an electronic auction between a prospective buyer and a plurality of prospective sellers with near perfect information (abstract), comprising:

a) inputting into a computer a buyer's request for offer (Fig.1 buyer 10, col. 55-57, product or service be defined by a buyer);

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b) communicating the request for an offer to at least two of the sellers (col. 3 L 8-17, request is communicated to potential suppliers, 30);

c) receiving offers, including terms of sale in response to the request for an offer, from at least two of the sellers (col. 3 L 18-24, bidders (suppliers) submit bids 58..., terms and conditions are indicated as ..RFQ which include specifications 50..);

f) receiving an adjusted offer from at least of the seller during a specified auction period (col. 4 L 4-13, ..participating bidder to see and begin planning their competitive responses);



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g) communicating information regarding at least some of the seller offers and at least part of the rating information to the buyer

Alaia, fails to teach steps d) automatically generating rating information about the seller offers and receiving and communicating the (rating) information to at least one other seller. Gindlesperger, in the same field of endeavor, however, teaches a method of facilitating an electronic auction between a prospective buyer and a plurality of sellers (abstract), comprising:

d) automatically generating rating information about the seller offers based on a plurality of predetermined criteria (Fig. 1 and col. 6 L 20 - col. 7 L 22, vendor capability attributes);

e) communicating the rating information regarding at least some of the seller offers to at least one other seller (col. 5, L 28-35, "transmits to the non-selected vendors...bidding result data..and the rank order value of the bid data);

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate steps of generating rating information about the seller offers and communicating the information to at least one other seller as disclosed by

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Gindlesperger into the method disclosed by Alaia to form the claimed invention because generating rating information about the seller offers would allow the buyer to evaluate the offer not just on the basis of price alone but also based on other critical considerations such as the sellers creditworthiness, experience level for delivering the offered product or services which are commonly evaluated by a buyer in conjunction with the competitive pricing at which the product is offered.

Communicating the information regarding the seller offers to other seller(s) would enable the seller to respond to current bids in association with the rating of the offers from other seller(s).

Claim 7-11: the computer is operated by a service provider unrelated to ..the buyer or the sellers (Alaia coordinator 20, shown in Fig. 1), independent destination on the WWW (web site of the coordinator (ex. Freemarket.com), this also is third party service. Various business arrangements recited in claims 10 and 11 are obvious and well-established business practices. For example, providing service on an out-source basis wherein a service provides acts as a primary contractor and hires a third party to acquire products or render services because of economical considerations.

Claim 12-15: inputting the request using graphical user interface with other related features recited are inherent to online auction wherein the auction is implemented via a web site of the provider as discussed in Alaia col. 3 L 61-63.

Claims 18-29: Alaia fails to explicitly disclose, however, Gindlesperger discloses a plurality of criteria concerning buyer preferences (refer to vendor selection criteria as discussed in Gindlesperger col. 4 L 55- col. 5 L 35). It would have been obvious to one of ordinary skill in the art at the time of invention to implement a plurality of criteria concerning buyer preferences because this would allow the buyer to select his/her preferred choice of payment methods, shipping methods etc.

Claims 19-29 are obvious variations of criteria or constraints concerning buyer request which include desired product, seller, transfer, payment characteristics and are anticipated by the cited art in a similar manner.

Claims 30-32, 77: wherein said request includes asking sellers to apply a suggestion module to said request (Alaia, col. 2 L 55-66, specification 50 for a desired product is a document that not only stipulate the buyers requirement regarding the products and services but also solicit information from the potential sellers whereby the sellers would provide

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suggestions to buyer regarding similar or alternative products, shipments, delivery schedules etc.).

Claim 33: buyer remains anonymous to said prospective sellers (Alaia, col. 4 L43-46, the information that can be displayed by the client application as shown in Fig. 6A-6D).

Claim 37: a software process initiates the communicating the request... (Alaia Fig. 2 and 3, col. 3 L 9-17).

Claim 38-39: communicating information about the buyer to at least one of the sellers (Alaia, col. 3 L 3-8, suppliers receive notices regarding upcoming auction as well as client software), ..in consideration to the buyer (Alaia, col. 3 L 3-8, suppliers participate in the buyer's auction).

Claims 47-50: cited references Alaia and Gindlesperger fail to explicitly disclose various forms of rating information. However, ranking of merchants, vendors and service providers in many different forms is old and well known. For example, out-sources vendors are ranked by a numerical score for each category of product or service they provide. It is stated that broadly interpreted, rating of vendors as disclosed by Gindlesperger cover all variations of rating information claimed herein.

Claim 51: seller information includes identity of the offerer (Gindlesperger, col. 5, L 30-35).

Claim 53: communicating of seller offers and rating information takes place during auction period (Alaia, auction period is indicated by Fig. 9A).

Claim 62: time remaining in the specified auction period (Alaia Fig 7A time line, col. 63-66).

Claims 63-68: buyer's auction includes specified auction parameters (Alaia Fig. 6A-9B).

Claims 69-70: adjusted offer expires after a time period specified by the offerer (Alaia schedule close, Fig. 7A, time period is 10:30 Hours), time specified by the offerer (time specified is 10:30).

Claim 74: communicating of seller offers and rating information to the buyer when a buyer-specified event occurs (vendors capability data and offer from a selected vendor is communicated to the buyer, Gindlesperger, col. 5 L 6-35).

Claim 76: ..side by side comparisons of a plurality of seller offers (Alaia, Fig. 8, refer to BIDDER and BID AMOUNT).

Claims 78-82: adding information about the auction to a database (Alaia, refer to Figures 6A-9B elements of database recited in dependent claims).

Claims 101: communicating an acceptance by the buyer..(inherent to any auction and therefore, Alaia method).

Claim 112: corresponds to and analyzed as in method claim 1.

8. Claims 2-6, 34-36, 107 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alaia and further in view of Gindlesperger as applied to claim 1 and further in view of Walker et al. (US Pat. 6,041,308) (Walker).

Claim 2: Alaia and Gindlesperger fail to teach, however, Walker, in the same field of endeavor, teaches a method of electronic shopping which comprises:

Inputting...a buyer's request for information about products..(conditional purchase offer, step 805, Fig. 8A);

Finding information in response to the request (Fig. 8A step 835);

Communicating at least part of the information to the buyer (step 884, 886, notify buyer).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate steps recited in claim 2 and disclosed by Walker into the method of claim 1 as obtained from combination of Alaia and Gindlesperger references as discussed above because it would allow the buyer to receive product purchase information a computer which would facilitate shopping decisions.

Claims 3-6 are customary steps to aid the buyer in communication and/or presenting product information and are old and well-known steps and official notice is taken to that effect. Various protocols and arrangements for electronic shopping as recited in claims 3-6 are variations obvious to those skilled in the art. Refer to claim 2 for motivation.

Claims 34-36: communicating of request for an offer includes searching a database for offers corresponding to the request (Walker, Fig. 2, offer database 500). Pre-compilation of database and compilation on the fly are old and well methods of database generation and updates and obvious to one of ordinary skill the art.

Claims 107-108: Alaia and Gindlesperger fail to teach, however, Walker, in the same field of endeavor, teaches a method of electronic shopping which comprises the step of automatically generating rating information about seller offers after the step of receiving adjusted offer (col. 4 L 21-24, eligibility criteria).

It would have been obvious to have the rating the seller offers before and after receiving an adjusted offer because it would enable the buyer to monitor the trend of rating information available during the course of the auction for each seller.

9. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alaia and further in view of Gindlesperger as applied to claim 1 and further in view of Chen (US Pat. 65,991,737) (Chen).

Claims 16-17: Alaia and Gindlesperger fail to teach, however, Chen, in the same field of endeavor, teaches a method of electronic shopping wherein a purchase request is input using a voice user interface (inherently includes natural language input) (Chen Col. 4 L 61- col. 5 L 16).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of claim 1 as disclosed by Alaia in view of Gindlesperger provide for input using a voice interface and further including natural language input per Chen reference because this would facilitate ordering of bidding in an interactive auction easier and faster than inputting via a typing the required inputs.

10. Claims 57-61 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alaia and further in view of Gindlesperger as applied to claim 1 and further in view of Mori et al. (EP 0 828 223 A2) (Mori).

Claims 57-61: Alaia and Gindlesperger fail to recite and Mori recites that the adjusted offer is adjusted at least in part by a computer algorithm (see abstract, and Figure 1).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the computer



algorithm per claims 57 including various features recited in dependent claims 58-61 because providing capability of computer algorithm for adjusting offers and using conventional rules and procedures by computer would make it unnecessary for the bidder to stay before the auction terminal and would allow more accurate and timely entry of auction information.

Claim 106: the step of automatically generating rating information occurs before the step of receiving an adjusted offer (Gindlesperger, col. 3 L 5 L 6-10).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WO 97/37315 to Fisher et al. teaches a method and System for processing and transmitting electronic auction information.

EP 0828223A2 Mori et al. Discloses an automatic auction method, which makes unnecessary for bidders to stay before auction terminals.

Van Lachine (US Pat. 6,223,163) discloses a method and apparatus for controlling offers that are provided at a point-of-sale.

Tozzoli et al. (US Pat. 5,717,989) teaches a Full service trade system.

Maes et al.; Agents That Buy and sell, Communications of the ACM, March 1999, Vol. 42, No. 3

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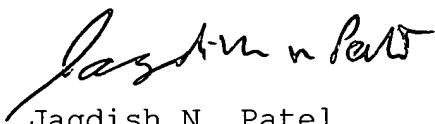
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Yannis Bakos; The emerging role of electronic marketplaces  
on the Internet, Communication of the ACM Pages: 35 - 42, August  
1998

Any inquiry concerning this communication or earlier  
communications from the examiner should be directed to Jagdish  
Patel whose telephone number is (703) 308-7837. The examiner  
can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are  
unsuccessful, the examiner's supervisor, Vincent Millin, can be  
reached at (703) 308-1038. The fax number for Formal or Official  
faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes  
may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of  
this application should be directed to the Group receptionist  
whose telephone number is (703) 308-1113 or 308-1114. Address  
for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup>  
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Jagdish N. Patel  
(Examiner, AU 3624)  
June 26, 2002